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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,255	08/22/2005	Hideyo Kikuchi	034185.057	2936

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EXAMINER

KASHNIKOW, ERIK

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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10/17/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No. 10/520,255	Applicant(s) KIKUCHI, HIDEYO	
	Examiner ERIK KASHNIKOW	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 24 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/06/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/24/08, 01/06/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 1-6 and 11 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected article, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 07/24/08.

2. Applicant's election with traverse of claims 7-10 in the reply filed on 07/24/08 is acknowledged. The traversal is on the ground(s) that the International Search Authority did not raise concerns about lack of unity. This is not found persuasive because it is up to the Examiner whether or not a Lack of Unity requirement is made, it is not required. The fact that the Examiner for the International Search Authority did not raise concerns about a Lack of Unity in no way prohibits a Lack of Unity requirement at a later date by an Examiner in the United States Patent and Trademark Office. It is the examiner's position that the requirement is proper given that it has been shown that the common special technical feature of groups I and II is known in the art, specifically, JP 04019139, and therefore there is a lack of unity since the claims fail to define a contribution over JP 040419139 (see MPEP 1850 II).

The requirement is still deemed proper and is therefore made FINAL.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

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The abstract should be in narrative form and generally **limited to a single paragraph** on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 9 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of copending Application No. 10/546,819. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the instant application requires a plurality of

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material rolls the copending application does not. However it is noted that the copending application uses comprising language and therefore does not limit the support layer to a single layer. It would have been obvious to one of ordinary skill in the art at the time of the invention to use more layers to increase the strength of the material. The copending claim is also silent regarding printing to the outer layer and forming a thermoplastic sheet to the inner and outer printed layers. It is obvious and well known in the art at the time of the invention to print on the outer layer of containers to aid in identifying as well as marketing a product. It is also known to one of ordinary skill in the art at the time of the invention to add sheets of thermoplastic material over printed layers to protect the printed layer.

6. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katayama et al. (US 6,044,628) in view of Balla (US 4,264,668).

9. In regards to claims 7 Katayama et al. teach a process for forming food packages (column 1 lines 7-14). Katayama et al. teach a method for forming webs wherein a

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plurality of support layer is wound around a roll (column 5 lines 14-18) which is then fed through an apparatus wherein identical sections of the web like material are sealed off (column 5 lines 28-37) (an obvious variant of sealing the lead end of the second roll to the tail end of the first roll). Katayama et al. teach that the seals at the ends may be formed by induction heating involving a metal foil layer at specific zones (column 6 lines 24-36). Katayama et al. teach that the web like material may comprise a variety of layers which may act as a support layer and an inner polyolefin layer (column 1 lines 45-50). However they are silent regarding printing a conductive layer at specific zones as well as printing a design directly or indirectly to the outer layer.

10. In regards to the printed container design layer it is obvious to one of ordinary skill in the art at the time of the invention to print include a printed design on an outer surface so that the contents of the package may be identified and advertised.

11. Balla et al. teach a web used to form packages (column 1 line 5-12).

12. Balla teaches that a printed conductive layer, which contains carbon black as a conductive filler, is used at specific zones to inductively heat the joints of the material (column 2 lines 3-20).

13. One of ordinary skill in the art at the time of the invention would be motivated to modify the invention of Katayama et al. with that of Balla because the invention of Balla would offer great accuracy through the printed layer in regards to the location of the sealing layer (column 2 lines 8-10).

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14. Claims 8 -10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katayama et al. (US 6,044,628) in view of Swisher (US 5,112,462)

15. In regards to claim 10 Katayama et al. teach a process for forming food packages (column 1 lines 7-14). Katayama et al. teach a method for forming webs wherein a plurality of support layer is wound around a roll (column 5 lines 14-18) which is then fed through an apparatus wherein identical sections of the web like material are sealed off (column 5 lines 28-37) (an obvious variant of sealing the lead end of the second roll to the tail end of the first roll). Katayama et al. teach that the seals at the ends may be formed by induction heating involving a metal foil layer (column 6 lines 24-36). Katayama et al. teach that the web like material may comprise a variety of layers which may act as a support layer and an inner polyolefin layer (column 1 lines 45-50). Katayama et al. teach that a layer of metal foil, which is a conductive material, may be laminated between an outer polyolefin layer, which would act as the support layer, and an inner polyolefin layer (column 1 lines 45-50). Katayama et al. also disclose cutting to form individual containers (column 5 lines 23-25).

16. As stated above Katayama et al. teach a method of forming films for packages, however they are silent regarding using vapor deposited or plated layers as the conductive layer as well as a printed container design.

17. In regards to the printed container design layer it is obvious to one of ordinary skill in the art at the time of the invention to print include a printed design on an outer surface so that the contents of the package may be identified and advertised

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18. Swisher teaches that it is known in the art that vapor deposited layers and electroplated layers are obvious variants of foil layers, which Katayama et al. teach (Katayama et al. column 6 lines 35 and 36) are used for the cross sealing.

19. One of ordinary skill in the art at the time of the invention would be motivated to modify the invention of Katayama et al. with that of Swisher because the invention of Swisher reduces the amount of waste materials (column 11 lines 15-20).

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The X (Takeo et al. JP 4019139) reference cited by the International Search Authority was an X reference for the non elected article claims. The reference could also have been used in place of Katayama et al for a 103 rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIK KASHNIKOW whose telephone number is (571)270-3475. The examiner can normally be reached on Monday-Friday 7:30-5:00PM EST (Second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Erik Kashnikow
Examiner
Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794